

USSN 09/285,632
Page 4

REMARKS

Claims 22-27, 41-42, 46-48, 50-56, 58, and 76-77 are pending. Claim 22 has been amended by this amendment. All claims are rejected. Applicants contend the instant amendment places the claims in form for allowance, or in the alternative, in better condition for the purpose of appeal. The amendment does not raise new issues and does not add new matter.

Applicants by this amendment further request clarification of one of the Examiner's citations which was not understood and appears to be a mistake.

35 CFR §103 REJECTION

Claims 22-26, 41, 42, 46-48, 50-54, and 58 continue to be rejected under 35 U.S.C. §103(a) as being unpatentable over Oshlack et al., (U.S. Pat. No. 5,639,476)

With respect to Applicants' arguments, the Examiner states,

"In response to applicant's argument that the reference does not show certain feature of applicant's invention, it is noted that the feature upon which applicant relies (i.e., rapidly dissolve coating) is not recited in the rejected claims....Applicant claims and specification do not disclose, mention, or require the invention to be a rapid dissolve coating; nor applicant claims exclude the coating to be a "control coating". ...Applicant's claims do not exclude the coating from "controlled release", "sustained release", or "delayed release". The time release being argued in page 3 or applicant's remarks is irrelevant with respect to the scope of the claims. The language "a coating" permits any type of coatings, including the control coating disclosed by Oshlack." (emphasis added).

"...applicant has not provide data showing detrimental effect in the present of the present of the water-insoluble polymer in such a small amount 0.1% (column 3, line 56). ...applicant's claim language does not exclude the "controlled release" coating taught by Oshlack, therefore, it was suggested that applicant provides data showing detrimental effect in the use of hydrophobic acrylic polymer in an amount of 0.1%."

"The use of the transitional phrase "consisting essentially of" in applicant's generic claim 22 does not exclude the use of a small amount of hydrophobic polymer taught by Oshlack, because the transitional phrase "consisting essentially of" limits the scope of a

GGC530-2 am7-24final

USSN 09/285,632
Page 5

claim to the specified materials and those that do not materially affect the basic and novel characteristic of the claim invention."

"The Declaration under 37 CFR 1.132 filed 04/12/03 has been fully considered, but is insufficient to overcome the rejection...because it does not provide a side by side comparison of the claimed invention and those of Oshlack to support the statement "adding hydrophobic acrylic polymer would result in loss of the rapid release". There was no data or experiment in the Declaration showing the coating containing 0.1% hydrophobic acrylic polymer in combination of water-soluble rate-controlling agent, erosion promoting agent, or pore-former that would result in loss of the rapid release. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness."

Applicants respectfully, but strongly disagree with the Examiner's conclusions and treatment of Applicants' arguments, particularly the Declaration a copy of which is resubmitted with this amendment.

The error in the Examiner's reasoning is exemplified by the underlined language above and repeated here, the language on page 5 of the instant Office Action, as follows: "The language "a coating" permits any type of coatings, including the control coating disclosed by Oshlack". Applicants are puzzled by this statement in which the Examiner must be looking only at the preamble of Applicants' claim 22 and ignoring the elements of the claim which define the "coating". Those elements recite starch with specific, enumerated modifications to improve solubility, a plasticizer and a modified cellulose, wherein the coating is water soluble and does not contain a water insoluble polymer. Clearly the claim when read as a whole cannot apply to "any type of coatings" when the preamble is read in light of the recited elements of the claim, which elements define the coating. For example, claim 22 recites a limitation that the coating does not contain water insoluble polymer and does include a starch with recited modifications which improve solubility. The Examiner is impermissibly ignoring the elements of the claim and the clear recognized meaning of terms within the claim.

Applicants are troubled by the Examiner's reasoning as recited above, particularly in view of the fact that as late as the Office Action of 8/9/02 the Examiner stated that "The Examiner notes that the reference briefly mentions the combination of hydrophobic acrylic polymer as a pore-former, with no further indication or explanation as to its function". Applicants have also set out this language in response to the

GGC530-2 am7-24final

USSN 09/285,632

Page 6

Examiner's bolded statement on page 6 of the instant Office Action suggesting that Applicants mischaracterized the Examiner's statements in the 11/18/02, Office Action regarding the presence of hydrophobic acrylic polymer in Oshlack et al. Applicant's 4/17/03 amendment said "Oshlack does not "briefly mention" use of hydrophobic acrylic polymer. Hydrophobic acrylic polymers are essential elements of all embodiments, as pointed out by Applicants previously, and Oshlack's hydrophobic acrylic polymers are not identified by Oshlack as "pore-formers". Applicants are concerned that the Examiner continues to misunderstand the teachings of Oshlack et al., particularly because Applicants have explained on numerous occasions that Oshlack's pore-formers are not Oshlack's acrylic polymers and that the acrylic polymers are hydrophobic.

Applicants further contest the fact that the Examiner has disregarded the Declaration (Exhibit A) and the starch literature (Exhibit B) submitted with the last amendment. The Examiner did not mention Exhibit B in her Office Action, and apparently disregarded Exhibit A because it does not contain exactly what she wants. The Examiner is bound to consider the full import of the Declaration and cannot dismiss its import out of hand. The data in the Declaration illustrates that the "soluble" nature of Applicants' formulations and elements of those formulation recited in claim 22 are indeed not time or delayed release formulations as taught by Oshlack et al. The declarant, clearly one skilled in the art, stated that "Adding hydrophobic acrylic polymer would result in loss of the rapid release". The Examiner has cited no authority or reason to ignore or doubt this statement which rebuts the Examiner's conclusory attempt to establish a prima facie case of obviousness.

The Examiner has provided no reasoning behind her request for data with 0.1% hydrophobic acrylic polymer, and Applicants submit that without some basis for the request, Applicants are under no obligation to run such tests. The Examiner's citation of Col. 3, line 56 of Oshlack et al. (page 5 of the Office Action) is not understood by Applicants and does not appear to bear upon the issue. Col. 3, lines 56 is "after exposure to accelerated storage conditions. The end-". Clearly 0.1% hydrophobic polymer is not taught by Oshlack et al., which teaches the use of 20-99.1% hydrophobic polymer when read together with Col. 11, lines 42-46 teach the use of 0.1% to 80% pore former. Applicants' claim 22 states that the coating does not contain a water insoluble polymer.

GGC530-2 am7-24final

USSN 09/285,632

Page 7

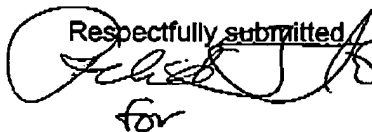
Applicants have run tests on the coatings of the invention, submitted a Declaration that acrylic polymers would result in loss of rapid release for the inventive coatings, and logically explained why there was no reason to include such comparative data in the original specification in view of the different objectives and different formulations. Applicant's Declaration was submitted to illustrate to the Examiner that the elements of its claim 22, defined to show that the coating is soluble and does not contain water insoluble polymers which would delay solubility, do lead to a coating that is readily soluble.

Applicants should not be under an obligation to submit the data requested by the Examiner when: (1) the meaning of "hydrophobic" and "hydrophilic" are clear to those skilled in the art, (2) the meaning of "soluble" and "insoluble" in water are clear to those skilled in the art, (3) the data submitted in Applicants' declaration illustrates the clear meanings of "soluble"; and (4) the time release data in the Oshlack et al. reference illustrate the meaning of "hydrophobic" and "insoluble" and "time release".

Applicant's specification specifically details the reasoning and desirable features behind the use of materials modified to provide improved solubility, particularly for coatings of enzyme granules used in detergents. Detergent wash cycles are typically only about 20 minutes or less which requires the coatings to dissolve rapidly in order for the enzyme to assist in cleaning action.

Applicants respectfully request reconsideration of the present Claims. Indeed, Applicants respectfully request withdrawal of the rejections. Accordingly, Applicants further request that the claims be permitted to proceed to allowance.

Date: August 8, 2003

Respectfully submitted
 #32,242
for

Janet Kaiser Castaneda
Registration No. 33,228

Genencor International, Inc.
925 Page Mill Road
Palo Alto, CA 94304
Tel: 650-846-4072
Fax: 650-845-6504

OFFICIAL

GGC530-2 am7-24final